



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Inventor: GOBLE, Nigel M.

Atty. Ref.: 2558-67

Serial No. 10/656,877

Group: 3739; Conf. No. 8081

Filed: September 8, 2003

Examiner: Gibson, Roy D.

For: UTERINE MORCELLATOR

* * * * *

April 4, 2007

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE

In the outstanding Office Action of February 20, 2007, the Examiner rejected claims 1-43 in the present application as being unpatentable over claims 1-27 of U.S. Patent No. 6,336,926 on the ground of nonstatutory obviousness-type double patenting. To overcome the Examiner's rejection, Applicant is submitting with this Response a Terminal Disclaimer. Accordingly, the Examiner's double patenting rejection of claims 1-43 should now be withdrawn.

If there are any questions regarding this submission, the Examiner is urged to call the undersigned at the telephone number listed below.

GOBLE, Nigel M.
Serial No.: 10/656,877

The fee for filing the Terminal Disclaimer is enclosed with this Response. However, the Commissioner is hereby authorized to charge any deficiency in the fee that may be due to the deposit account of Nixon & Vanderhye, Account No. 14-1140.

Respectfully submitted,

NIXON & VANDERHYE P.C.

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TERMINAL DISCLAIMER TO OBIATE A DOUBLE PATENTING
REJECTION OVER A "PRIOR" PATENTDocket Number (Optional)
2558-67In re Application of: GOBLE, Nigel M.
Application No.: 10/656,877

Filed: September 8, 2003

For: UTERINE MORCELLATOR

The owner*, Gyrus Medical Limited, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term prior patent No. 6,336,926 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said prior patent is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, "as the term of said prior patent is presently shortened by any terminal disclaimer," in the event that said prior patent later:

- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. The undersigned is an attorney or agent of record. Reg. No. 29,834

Robert A. Molan

Signature

April 4, 2007

Date

Robert A. Molan

Typed or printed name

703-816-4000

Telephone Number

Terminal disclaimer fee under 37 CFR 1.20(d) included.

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*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

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